

REMARKS/ARGUMENTS

In the Non-Final Office Action of April 12, 2007 (the "Office Action"):

1. Claims 18-37 are subject to restriction;
2. Claims 18, 19, 21, 22, 30, 31 are rejected under 35 USC 102(e) as being anticipated by U.S. 6,726,699 issued to Wright et al. ("Wright");
3. Claim 22 is rejected under 35 USC 103(a) as being unpatentable over Wright in view of U.S. 5,320,611 issued to Bonutti et al. ("Bonutti");
4. Claims 23, 24 are rejected under 35 USC 103(a) as being unpatentable over Wright and Bonutti, and further in view of U.S. 6,224,608 issued to Ciccolella et al. ("Ciccolella"); and
5. Claims 23, 25-29 are rejected under 35 USC 103(a) as being unpatentable over Wright and Bonutti, and further in view of U.S. 4,655,752 issued to Honkanen et al. ("Honkanen").

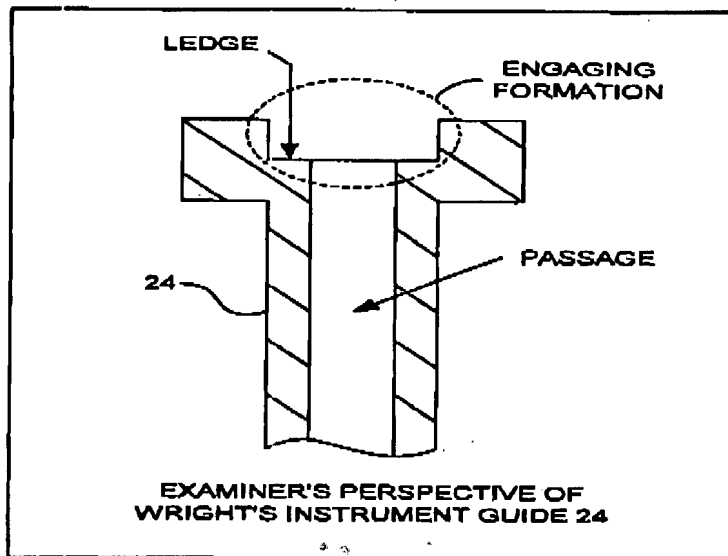
1. Election/Restrictions

Applicants hereby elect without traverse to prosecute Claims 18-33 (Invention I) in the present application. Accordingly, Claims 34-39 (Inventions II and III) have been cancelled.

2. Rejection of Claims 18, 19, 21, 22, 30 and 31 under 35 USC 102(e) as being anticipated by Wright

Claim 18 claims a tool guide comprising an elongate body and an engaging formation defined within a passage of the body, wherein the engaging formation is arranged "to hold and provide a stop for a complementary engaging formation on a robotic arm so that a passage defined within the complementary engaging formation is aligned with the passage of the elongate body."

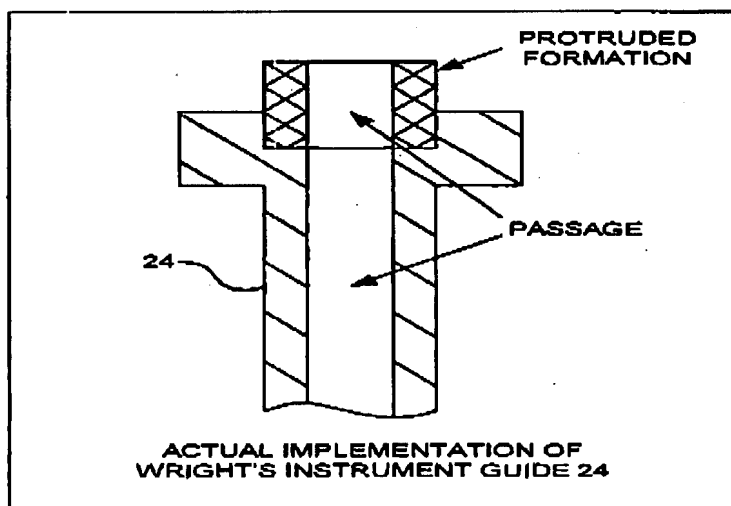
In rejecting Claim 18, it appears that the Examiner's perspective of the proximal end of Wright's instrument guide 24 is as illustrated below, where the engaging formation is shown in the dotted area, and an apparent recessed area within the engaging formation is arranged to hold and an apparent ledge provides a stop for a complementary engaging formation on a robotic arm. In this case, the complementary engaging formation would necessarily have to be a protruded (or male) formation on Wright's tool driver 20.



However, there is absolutely nothing in the description of Wright's instrument guide 24 to support this perspective. In fact, there is virtually no explanation of how Wright's instrument guide 24 is coupled to Wright's tool driver 20. All that is described is "the guide tube 38 (which is a portion of the guide 24) may be attached to the tool driver 20. See Col. 2, lines 51-54.

In applicants' Amendment of September 26, 2006, however, it was explained that "Figure 1 in Wright illustrates a spring-loaded or threaded mechanism to facilitate removably coupling the instrument guide 24 to the tool driver 20. Applicants (i.e., applicants' attorney, Frank Nguyen) consulted with Mr. Paul Milman, a former Computer Motion Inc. engineer who is familiar with the design taught by Wright. Computer Motion Inc., the assignee of Wright, and all its product lines were acquired by Intuitive Surgical, the assignee of the present invention in August 2003. Mr. Milman indicated that the instrument guide 24 has a protruded formation which protruded formation when inserts into a receptive formation on the tool driver 20 can be locked in place either by a twisting action or by engaging a spring-loaded pin."

Thus, Mr. Milman refutes the Examiner's perspective of the proximal end of the instrument guide 24. In particular, the commercialized version of Wright's instrument guide 24 is shown as follows:



In this case, the cross-hatched area is a cross-sectional of a solid protruded formation. Since this area was left unhatched in Figure 1 of Wright, the Examiner apparently interprets it as being hollow so as to support the Examiner's perspective above. However, such is not the case in the commercialized version of Wright's instrument guide. Figure 1 of Wright is ambiguous at best, since the description is silent on whether or not the unhatched area (which the Office Action points to as being an engaging formation) is hollow or solid. Therefore, reconsideration of the rejection of Claims 18, 19, 21, 22, 30 and 31 under 35 USC 102(e) as being anticipated by Wright is respectfully requested since any rejection of the claims based upon a non-described and ambiguous portion of a prior art reference's drawing can only be based upon inappropriate hindsight reasoning.

Accordingly, Claim 18 is believed to be patentable under 35 USC 102(b) over Wright for at least the foregoing reasons.

Claims 19, 21, 22, 30 and 31 are also believed to be patentable under 35 USC 102(b) over Wright since they depend from Claim 18, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 18.

3. Rejection of Claim 22 under 35 USC 103(a) in light of Wright & Bonutti

Claim 22 depends from Claim 18, and as such, is believed to be patentable under 35 USC 103(a) in light of Wright and Bonutti for at least the same reasons stated in reference to Claim 18, as well as any other reasons stated in previous communications.

Applic. Serial No.: 10/624,848

- 8 -

Att. Docket No.: 017516-006810US

4. Rejection of Claims 23, 24 under 35 USC 103(a) in light of Wright & Ciccolella

Claims 23 and 24 are believed to be patentable under 35 USC 103(a) in light of Wright and Ciccolella since they depend from Claim 18, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 18, as well as any other reasons stated in previous communications.

5. Rejection of Claims 23, 25-29 under 35 USC 103(a) in light of Wright & Honkanen

Claims 23 and 25-29 are believed to be patentable under 35 USC 103(a) in light of Wright and Ciccolella since they depend from Claim 18, and as such, are believed to be patentable for at least the same reasons as stated in reference to Claim 18, as well as any other reasons stated in previous communications.

Claims 18, 19, 21-31 remain pending in the application. Claims 1-17, 20, and 32-39 have been cancelled. Reconsideration of the rejection of the pending claims is respectfully requested, and an early notice of their allowance earnestly solicited.

Respectfully submitted,

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Applic. Serial No.: 10/624,848

- 9 -

Atty. Docket No.: 017516-006810US